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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,130	02/13/2004	Sean Register	22111.00	3808

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EXAMINER	
CHAPMAN, JEANETTE E	
ART UNIT	**PAPER NUMBER**
3635	

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/777,130	REGISTER, SEAN	
	Examiner	Art Unit	
	Chapman E. Jeanette	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-14 and 16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 9-14, 16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4-7, 9, 12-14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (5571596) in view of Gregg et al (6787486). Johnson discloses a wind resistant roof slate assembly comprising:

1. a plurality of generally rectangular lightweight overlapping roof slates
2. a plurality of windlock anchors of nails which may be employed for directly securing the mounting end of the slates to a roof of a building; see figures 1-3
3. the windlock members may extend through the mounting end into the roof to provide a wind resistant connection; see figures 6B and 7
4. a sealer applied to the top surface of the slate; the particular type of sealer has been considered a matter of choice; one of ordinary skill in the art would have appreciated using any known sealer capable of fulfilling the intended function of the roof assembly

Johnson discloses of a nail; the claims recite a screw with a washer. Screws are known alternative over nails providing a more adjustable securing means. Johnson also discloses an asphalt/mortar adhesive on the top layer to adhere the slate below to the slate above; the above referenced application discloses adhesive on the bottom to

secure the slate above to the slate below; both methods teach adhering adjacent courses of slates by the use of adhesive to the slate. The significance of one method over another is not viewed as critical but within the scope of the invention to Johnson.

Johnson discloses a concrete slate but lacks that of aerated conclaved type as disclosed by Gregg et al. It would have been obvious to one of ordinary skill in the art to modify Johnson to employ this type of concrete because this type of concrete has good strength, low weight, good thermal insulation properties, good sound deadening properties and high resistance to fire as taught by Gregg et al.

The dimensions or measurements of the slate has been considered a matter of choice: one of ordinary skill in the art would have appreciated making the slate of any dimensions while the roof slate remain capable of fulfilling the intended use, function and purpose.

Claims 2-3, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Pike (5533313). Pike discloses a plurality of roof slates having weatherproof underlayment 60 of granular felt. The mounting end of the roof slates are mounted to the underlayment by windlock members 80. It would have been obvious to one of ordinary skill in the art to modify Johnson to include the underlayment to provide a weatherproof roof structure.

Response to Arguments

Applicant's arguments filed 8/22/06 have been fully considered but they are not persuasive. Applicant claims that because Johnson states that the concrete shingles can withstand hail and wind damage "if" made thick enough ..... this disclosure

does not prohibit the use of the aerated autoclaved concrete. In fact using the material, the same would permit the shingles to withstand hail and damage without requiring additional underlying structure and not be as costly. Therefore, the Johnson structure is not teaching away from the concrete. The emphasis on the non-cementitious, composite laminate using materials such as Kevlar, E-glass and carbon fibers, does not preclude the use of the recited structure. The Gregg et al reference is not being bodily incorporated into Johnson but is cited to show the advantages of using aerated concrete. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Applicant states the Gregg et al reference is directed to a panels. A shingle is a building structure of a panels.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gregg et al suggest a multiplicity of uses for the building material. Hence, the material is limited to

one particular building structure The material is known for its favorable properties of strength, low weight, good thermal insulation, good sound deadening properties and high resistance to fire which are imparted to any structure to which it is employed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeanette Chapman
Primary Examiner
Art unit 3635

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